

REMARKS/ARGUMENTS

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe the subject matter which applicant regards as the invention.

Claim 55 has been amended to provide proper antecedent basis for the limitation "said cable."

Claims 51-68 have been rejected based on the doctrine of "provisional obviousness-type double patenting" over claims 1-34 of pending U.S. Patent Application 10/054,479. Applicants understand this to mean "provisionally rejected" for obviousness-type double patenting. A terminal disclaimer will be filed at the appropriate time, if necessary.

Claims 51 and 64-68 were rejected under 35 U.S.C. 102(b) over U.S. Patent No. 5,545,191 to Mann et al. (hereinafter "Mann"). For the following reasons, the rejection is respectfully traversed.

The Examiner is reminded that in order to support a rejection under 35 U.S.C. 102, a cited reference must *teach*, either expressly or implicitly, *each and every limitation* of the rejected claim. If a reference is completely silent as to a particular limitation, it cannot be said to *teach* that limitation.

Specifically, regarding claim 51, Mann does not teach "a part of a casing of said hearing apparatus forming a dielectricum of said capacitance," as required. Applicants agree with the Examiner that Mann does teach the use of a capacitive coupling as a way for an external unit (52) to communicate with an implanted unit (12) of a hearing device (column 5, line 15). However, Mann does not specify what would be used as a dielectricum in such a capacitive coupling.

Clearly, there are ways to form a dielectricum without using part of the casing of the hearing apparatus. Therefore, Mann cannot be considered to *anticipate* the requirement of claim 51 that a part of the casing of the hearing apparatus forms the dielectricum.

Presumably, if it were taught that one of the capacitive plates were formed *inside* of the casing, it could be inferred that the casing would serve as a dielectricum for a corresponding capacitive coupling. However, Mann explains that Velcro pads (55,56) would be made conductive for the purpose of providing a capacitive coupling (Mann, column 5, lines 7-17, with reference to Fig. 4). Thus, the Velcro pads (55,56), which are located on the *outside of the casing* of the external unit (52), would act as one plate of the capacitance. Some part of the implanted unit (12) would act as the other plate. Since, as taught by Mann, the casing of the external unit (52) would not be positioned between the two plates, it would not be possible for a part of the casing of the external unit (52) to act as a dielectricum, as required by claim 51. There is no disclosure in Mann of how the capacitive plate is implemented on the implanted unit (12) nor whether a housing of the implanted unit (12) would serve as a dielectricum.

In summary, Mann does not *teach* any details regarding the structure and location of a dielectricum for the capacitive coupling, and therefore cannot be considered to *anticipate* the dielectricum limitation of claim 51. Since claims 64-68 each depend from claim 51, they are not anticipated by Mann for the same reasons.

Claims 52-63 were rejected under 35 U.S.C. 103(a) as being unpatentable over Mann. For the following reasons, the rejection is respectfully traversed.

As explained above with regard to claim 51, from which claims 52-63 depend, Mann does not teach “a part of a casing of said hearing apparatus forming a dielectricum of said capacitance.” Further, Mann does not provide any suggestion or motivation to modify its

teachings to include this required limitation. If the Examiner considers this limitation to be suggested by the prior art, Applicants respectfully request a detailed explanation of where the suggestion or motivation can be found.

Further, as mentioned above, Mann that Velcro pads (55,56) would be made conductive for the purpose of providing the capacitive coupling between the external unit (52) and the implanted unit (12). This effectively teaches away from using the housing of the external unit (52) as the dielectricum, rendering such a modification non-obvious. Therefore, absent evidence that a suggestion or motivation to make such a modification would be found in the prior art by one of ordinary skill in the art of hearing devices at the time the present invention was made, rejection of claims 52-63 cannot stand.

Further, regarding claims 52-55 and 59-63, Applicant respectfully submits that the Examiner has not explained what limitations are considered obviousness and why. The Examiner has simply address all of these claims by asserting that providing a suitable metal material for the housing would be obvious. Each of claims 52-55 and 59-63 recites specific limitations which are not addressed by the Examiner. Further, none of these claims actually includes the "metal material" limitation that has been addressed by the Examiner. For example:

Claim 52 relates to a material that form a dielectricum;

Claim 53 relates to the location of the electrical connection;

Claim 54 relates to the nature of the electrical connection;

Claim 55 requires a one-lead cable;

Claim 59 requires that a surface of the dielectricum has a surface exposed to
ambient;

Claim 60 requires that the surface of claim 59 is flush;

Claim 61 relates to a reference potential electrode provided for electronics of the hearing apparatus being adapted to contact a human body;

Claim 62 requires a one-lead cable and human body contacting reference potential electrode; and

Claim 63 requires that the reference potential electrode of claim 62 comprises a capacitance plate and dielectric material.

The Examiner has not addressed any of these limitations in the rejection. It is respectfully submitted that Applicant is entitled to have each claim limitation addressed and the basis of any contention of obviousness clearly explained.

Further regarding claim 56, Applicants respectfully submit that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to provide a capacitive coupling that is operationally connected to an optical cable as required. The mere fact that providing optical cables for transmitting signals for hearing aids is "very well known in the art," as stated by the Examiner, does not by itself render it obvious to modify Mann to connect the capacitance and optical cable as claimed. A specific teaching or suggestion of the required limitations is needed to support such a rejection. If the Examiner considers these specific limitations of claim 56 to be suggested by the prior art, Applicants respectfully request a detailed explanation of where the suggestion or motivation can be found.

Further regarding claim 57, one of ordinary skill in the art would not be motivated to modify Mann so that "said electrical connection is detachably held together by means of cooperating magnetic parts," as required. Mann teaches away from the using such cooperating magnetic parts:

Advantageously, the invention provides for reliable attachment of an external unit to the skin in the proper location over an implanted unit for optimally coupling

the units, which does not suffer from the potentially tissue damaging effects of permanent magnets (due to excessive compressive pressure applied to the tissue), and does not reduce the internal space available within the internal unit.

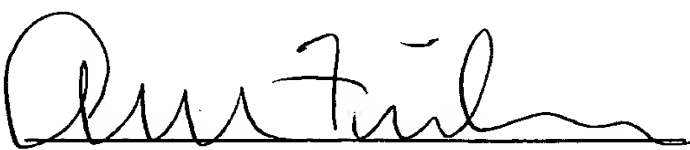
(column 6, lines 35-41) Thus, modifying Mann's teachings in direct contravention of its teachings is non-obvious. Further, Mann states that a detachable magnet can be used in the process of aligning the VELCRO. Once attached, the VELCRO is used to hold the external unit in place so that the use of a magnetic coupling can be avoided. Since Mann repeatedly teaches away from providing cooperating magnetic parts, which are required by claim 57 for holding the electrical connection together, claim 57 and its dependent claim 58 are not rendered obvious by Mann and the rejection cannot be maintained.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 33422.

Respectfully submitted,

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